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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,555	03/30/2004	Vihar C. Surti	10000/125	6408
757	7590	02/13/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			KOHARSKI, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/802,555	SURTI, VIHAR C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher D. Koharski	3763	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 8, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/30/2004</u>   | 6) <input type="checkbox"/> Other: _____                                    |

***Information Disclosure Statement***

The information disclosure statement (IDS) that was submitted on 3/30/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

***Claim Objections***

Claim 8 is objected to because of the following informalities: The claimed subject matter is not supported in the drawing supplied by Applicant (see below, Drawings). Appropriate correction is required.

Claims 13 and 15 are objected to because of the following informalities: Regarding claim 13 the terms "a second passageway" has a lack of antecedent basis from the independent claim 5, wherein no passageway is described. Regarding claim 15 the terms "a third passageway" has a lack of antecedent basis from the independent claim 5, wherein no passageway is described. Appropriate correction is required.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, in claim 8, "...the upper magnet comprises a bullet-shaped recess and the lower magnet is bullet shaped..." must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

Claims 1, 3-6, 19 are rejected under 35 U.S.C 102(b) as being anticipated by Hendren, III (3,986,493). Hendren, III discloses an electromagnetic bougienage method for lengthening atretic segments.

Regarding claims 1, 3-6, Hendren, III discloses a medical device for joining two segments, comprising a first and second catheter with magnets (30, 46) associated on each end (Figure 1). Wherein the lower magnet is slidably disposed on the distal end on the gastric catheter (Figure 3). The first and second magnets are configured to mate using electromagnetic forces (col 1, ln 40-55).

Regarding claim 19, Hendren III discloses a method for joining two atretic segments (Figures 5-8) wherein an esophageal and gastric catheter are used with magnetic forces to join the two sections.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C 103(a) as being unpatentable over Hendren III. Hendren III meets the claim limitations as described above but does not include a magnet slidably disposed on the esophageal catheter.

It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the esophageal catheter as taught by the gastric catheter of Hendren, III with the slidably disposed magnet, because Applicant has not disclosed that the slidably disposed magnet provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either of the catheters disclosed by Hendren, III, because it provides the ability to move the magnet and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Hendren, III.

Therefore, it would have been an obvious matter of design choice to modify Hendren, III to obtain the invention as specified in the claim.

***Claim Rejections - 35 USC § 103***

Claims 7-8 are rejected under 35 U.S.C 103(a) as being unpatentable over Hendren, III in view of Rudie (3,771,526). Hendren, III meets the claim limitations as described above but does not include magnets shaped in the claim limitations.

However, Rudie teaches an anastomosis clamp. Regarding claims 7-8, the reference teaches the use of an anastomosis clamp system wherein the two engaging means are shaped in multiple ways to engage themselves (Figures 5 and 11).

At the time of the invention, it would have been obvious to use the shaped engaging means of Rudie with the magnet system of Hendren III. The addition of the surface modified tissue engaging regions provides a unique surface to meet and connect the tissues. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Rudie.

***Claim Rejections - 35 USC § 103***

Claims 9-16, are rejected under 35 U.S.C 103(a) as being unpatentable over Hendren, III in view of Burkett et al. (2003/0139703). Hendren, III meets the claim limitations as described above but does not include a guide wire passage, valve, catheter hub, balloon member, and ports.

However, Mager et al. teaches a balloon catheter. Regarding claims 9-11, the reference teaches the use of a guide wire and guide wire channel ([0137]) and Hendren, III shows a magnetic element attached to guide wire type element (Figure 3).

Regarding claim 12, Mager et al. teaches the use of a valve (113) on the catheter hub (Figure 9).

Regarding claims 13-14, Mager et al. teaches the use of a balloon (103) on the distal end of the catheter (Figure 9) that is controlled from the catheter hub.

Regarding claims 15-16, Hendren III, discloses a port on one of the catheters, but Mager et al. teaches the use of a multiple ports (106) on the catheter body (Figure 9) that are in fluid communication with the catheter hub.

At the time of the invention, it would have been obvious to use the balloon, guide wire, and ports of Mager et al. with the catheter system of Hender et al. The addition of the balloon provides the user with the ability to inflate a means for securing or adjusting tissue within the body. The addition of the guide wire allows for the ease of use for placement of the catheter within the body. Finally the addition of the multiple ports allows for the use of these ports of both catheters for fluid removal or introduction of therapeutic drugs, or feeding liquids. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Mager et al.

***Claim Rejections - 35 USC § 103***

Claim 17 is rejected under 35 U.S.C 103(a) as being unpatentable over Hendren, III in view of Auzin et al. (2,308,484). Hendren, III meets the claim limitations as described above but does not include the distal element being secured by a band.

However, Auzin et al. teaches a general use inflatable catheter. The reference teaches the use of band placed on the balloon to additionally secure the balloon end and reinforces the assembly elements (Figure 6).

At the time of the invention, it would have been obvious to use the band assembly of Auzin et al. with the magnetic elements of Hendern, III. The addition of the band attachment provides an easy method of construction and allows for the removal of the end distal elements. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Auzin et al.

***Claim Rejections - 35 USC § 103***

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendren, III in view of Mager et al. in further view of Burkett et al. (2003/0139703). Hendren, III meets the claim limitations as described above but does not include the gastric catheter with a balloon, ports, and associated pathways.

However, Burkett et al. teaches a tube device and method for the same. Regarding claim 18, the reference teaches a gastric catheter with a balloon (44) and a hub in fluid communication with each (Figure 9). Mager et al. teaches a plurality of ports (106).

At the time of the invention, it would have been obvious to use the balloon of Burkett et al. and ports of Mager et al. with the catheter system of Hender et al. The addition of the balloon provides the user with the ability to inflate a means for securing or adjusting tissue within the body. The addition of the multiple ports allows for the use

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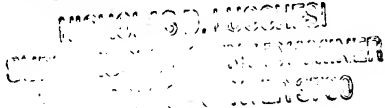
of these ports for fluid removal or introduction of therapeutic drugs, or feeding liquids. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Mager et al. and Burkett et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on Monday through Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/31/06  
[Date]  
  
Christopher Koharski  
Examiner  
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